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In re Application of

XIONG et al.

Application No.: 10/551,359

PCT No.: PCT/CA2004/000464

Int. Filing Date: 29 March 2004

Priority Date: 28 March 2003

Attorney Docket No.: 577132000200

For: OVERCOMPLETE BASIS TRANSFORM-
BASED MOTION RESIDUAL FRAME CODING
METHOD AND APPARATUS FOR VIDEO
COMPRESSION

DECISION

This is a decision on applicants' renewed petition under 37 CFR 1.47(a) filed 11 December 2006 in the United States Patent and Trademark Office (USPTO). The petition is **DISMISSED** without prejudice.

BACKGROUND

On 29 March 2004, applicants filed international application PCT/CA2004/000464, which designated the United States and claimed a priority date of 28 March 2003. A copy of the international application was communicated from the International Bureau to the USPTO on 07 October 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 28 September 2005.

On 28 September 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 11 May 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(h) for filing any of the search fee, the examination fee, or the oath or declaration after the date of the commencement of the national stage were required.

On 11 December 2006, applicants filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a petition/fee for a five month extension of time, the surcharge under 37 CFR 1.492(h), a declaration of facts by Leslie Sims, two copies of a letter to non-signing inventor Meng Wang from Leslie Sims dated 20 November 2006, a copy of a shipping label from Mobile1 Messengers Inc. to Meng Wang, a copy of a package tracking sheet from Canada Post Corporation, and a copy of a registered mailing label to Meng Wang's last known address.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Items (1) and (3) have been met.

Item (2) has not been met. It is not clear whether it is being alleged that Meng Wang refuses to execute the application or that he cannot be reached after diligent effort. The two are distinct. *See, e.g.*, MPEP 409.03(d), item I. "Inventor Cannot Be Reached" and item II. "Refusal to Join." It is not clear that either of the packages sent to Mr. Wang's last known address were received by him. The shipping label from Mobile1 Messengers Inc. indicates that four attempts were made to deliver but there is no indication that the package finally was delivered. The tracking sheet from Canada Post Corporation indicates that the package was received at the Post Office for pick up as a carded item but does not indicate that the package was picked up. The copy of the registered mailing label to Meng Wang's last known address also fails to show receipt. If neither letter was picked up or delivered, it may be because Mr. Wang does not reside at this address.

If it is being alleged that Mr. Wang refuses to sign, it must be established that he lives at this address. Additionally, to establish a refusal to sign, it is required that the inventor be presented with the application papers (specification, including claims, drawings, and oath or declaration). *See* MPEP 409.03(d). "It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956)." Here, it is not clear that Mr. Wang was presented with the application papers. While the letter dated 20 November 2006 refers to "patent application 2,423,618" and indicates that Mr. Weng should "feel free to keep the copy of the Application for [his] records", it does not appear that a copy of the PCT international application (which may be different from the priority application) or a copy of the U.S. national stage application (which should be the same as the PCT international application but may be different from the priority application) were presented to him.

If it is being alleged that Mr. Wang cannot be reached or found, a bona fide attempt to find his address must be made and copies of documentary evidence such as *internet searches*, certified mail return receipts, cover letters of instructions, and telegrams, that support a finding that the non-signing inventor could not be found or reached should be made part of the affidavit or declaration. See MPEP § 409.03, item I. It does not appear that any internet searches were conducted to find Mr. Wang's address.

Item (4) has not been met. The declaration filed 21 May 2008 is an improper composite declaration, consisting of one Page 1 and three Page 2's. Each inventor must be presented with a complete declaration which lists all of the inventors, and the signature of each inventor must appear on at least one complete declaration. Multiple complete declarations may be submitted, but it is not permissible to combine pages of separate documents.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web or if mailed should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Daniel Stemmer/

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